

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS
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V.O

APPLICATION NO.	FILING DATE	HUGHES	FIRST NAMED INVENTOR	D	ATTORNEY DOCKET NO.
08/825,492	03/26/97				

LM01/0104

HSU, A EXAMINER

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2nd UNIT	PAPER NUMBER
	4

01/04/99

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/825,492	Applicant(s) HUGHES ET AL
	Examiner Alpus H. Hsu	Group Art Unit 2731

Responsive to communication(s) filed on Oct 13, 1998

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1-3, 5-8, 14-16, and 18-23 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1-3, 5-8, 14-16, and 18-23 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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1. Applicant's arguments with respect to claims 1-3, 5-8, 14-16, 18-20 have been considered but are moot in view of the new ground(s) of rejection.
2. The drawings are objected to because all blocks in Figs. 1, 3 and 4 should be labeled with descriptive legends known in the art. Correction is required.
3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 21-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 21-23 are directed to a data format which does not belong to any statutory subject matter as indicated above.

6. The following is a quotation of the first paragraph of 35 U.S.C. § 112:
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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7. The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to provide an enabling disclosure.

The disclosure does not provide enough structural detail to enable an artisan to make and use the invention without undue experimentation.

The Court of Customs and Patent Appeals has held that, a disclosure which gives only a block diagram and a broad description of the functions of those blocks without disclosing the specific structure of the blocks or explaining the interconnection, timing and control of the various components is *prima facie* not enabling. In re Gunn, 190 U.S.P.Q. 402 (CCPA 1976). A conclusion of nonenablement is rebuttable, but the burden is upon applicant to come forward with evidence of enablement with regards to the specific invention claimed. *Id.* at 405.

The drawings in this case are a series of block diagrams. The detailed description does not specify any structure for the various blocks or explain how the components connect to each other and interact with each other to perform the functions claimed.

The specification answers none of these questions. Absent answers or evidence showing that an artisan would have known the answers without resort to undue experimentation, the disclosure is *prima facie* non-enabling under the rationale set forth in Gunn *supra*.

To comply with the enablement clause of the first paragraph of 35 U.S.C. § 112, the disclosure must adequately describe the claimed invention so that the artisan could practice it without undue experimentation. In re Scarbrough, 500 F.2d 560, 182 U.S.P.Q. 298 (CCPA 1974); In re Brandstadter, 484 F.2d 1395, 179 U.S.P.Q. 286 (CCPA 1973); In re Gay, 309 F.2d

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769, 135 U.S.P.Q. 311 (CCPA 1962). If the Examiner has a reasonable basis for questioning the sufficiency of the disclosure, the burden of proof shifts to applicant to come forward with evidence to rebut this challenge. In re Doyle, 482 F.2d 1385, 179 U.S.P.Q. 227 (CCPA 1973); In re Brown, 477 F.2d 946, 177 U.S.P.Q. 691 (CCPA 1973); In re Ghiron, 442 F.2d 985, 169 U.S.P.Q. 723 (CCPA 1971).

Applying this case law to the facts of this case, as discussed above the examiner believes that he has made out a reasonable *prima facie* case that the instant disclosure is not enabling. Thus the burden is on applicant to come forward with evidence showing enablement.

8. Claims 1-3, 5-8, 14-16, 18-20 are rejected under 35 U.S.C. 112, first paragraph, for the reasons set forth in the objection to the specification.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

10. Claims 1-3, 5-8, 14-16, 18-20 are rejected under 35 U.S.C. 102(a) as being anticipated by Takashima et al. (of record).

By broadly interpreting the ATM cells (cells #1, #2, ... etc.) as the claimed partially filled ATM cells, and the new ATM cell (10) as the claimed merged ATM cell, Takashima et al. discloses a method and apparatus for merging partially filled ATM cells in ATM communications

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network (col. 10, lines 10-53, col. 14, line 30 to col. 15, line 26, and Figs. 28-31) as in claims 1-3, 5-8, 14-16, 18-20.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lakshman et al. and Duault are further cited to show the feature of partially filled ATM cells used in ATM system for data communication purpose similar to the claimed invention.

12. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 305-9051, (for formal communications intended for entry)

Or:

(703) 305-9508 or 308-5403 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alpus H. Hsu whose telephone number is (703) 305-4377. The examiner can normally be reached on Monday-Friday from 6:30 a.m. to 4:00 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi Pham, can be reached on (703) 305-4378.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Alpus H. Hsu 1844

December 24, 1998



ALPUS H. HSU
PRIMARY EXAMINER